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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,698	02/12/2004	Marvin L. Green	IN-5630	5722

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/777,698	Applicant(s) GREEN ET AL.	
	Examiner Terressa M. Boykin	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Art Unit: 1711

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1- 42 are rejected under 35 U.S.C. 102(e) as being anticipated by US 20040235997 see pages 2-10, claim 25.**

The reference discloses coating materials which are curable thermally, or thermally and with actinic radiation, for producing single-coat and multicoat clearcoat systems and color and/or effect paint systems and the use of the novel coating materials curable thermally, and with actinic radiation, as adhesives and sealing compounds for producing adhesive films and seals.

The reference notes that the further essential constituent of the coating materials of the invention is at least one binder (A). Binders (A) are selected from the group consisting of random, alternating and block, linear, branched and addition (co)polymers of ethylenically unsaturated monomers, polyaddition resins and/or polycondensation resins curable physically, thermally, or thermally and with actinic radiation.

Where thermally self-crosslinking binders (A) are used, the dual-cure coating materials of the invention comprise at least one of the below-described

Art Unit: 1711

constituents curable with actinic radiation and/or of the dual-cure constituents. Where thermally externally crosslinking binders (A) are used, the thermally curable coating materials of the invention further comprise at least one of the thermally curable constituents described below, and the dual-cure coating materials of the invention comprise at least one of the thermally curable constituents described below and at least one of the constituents described below that is curable with actinic radiation, and/or at least one of the dual-cure constituents described below. Examples of suitable addition (co)polymers (A) are (meth)acrylate (co)polymers or partially saponified polyvinyl esters, especially (meth)acrylate copolymers. Examples of suitable polyaddition resins and/or polycondensation resins (A) are polyesters, alkyds, polyurethanes, polylactones, polycarbonates, polyethers, epoxy resin-amine adducts, polyureas, polyamides, polyimides, polyester-polyurethanes, polyether-polyurethanes or polyester-polyether-polyurethanes, especially polyesters.

Examples of suitable other hydroxyl-containing olefinically unsaturated monomers (a2) are hydroxyalkyl esters of olefinically unsaturated carboxylic, sulfonic and phosphonic acids and acidic phosphoric and sulfuric esters, especially carboxylic acids, such as acrylic acid, beta-carboxyethyl acrylate, methacrylic acid, ethacrylic acid and crotonic acid, particularly acrylic acid and methacrylic acid. They are derived from an alkylene glycol, which is esterified with the acid, or are obtainable by reacting the acid with an alkylene oxide such as ethylene oxide or propylene oxide. I

One example of introducing reactive functional groups (i) by way of

polymer-analogous reactions is the reaction of some of the hydroxyl groups present in the binder (A) with phosgene, to give resins containing chloroformate groups, and the polymer-analogous reaction of the chloroformate-functional resins with ammonia and/or primary and/or secondary amines to give binders (A) containing carbamate groups. It is possible, moreover, to introduce carboxyl groups by the polymer-analogous reaction of some of the hydroxyl groups with carboxylic anhydrides, such as malic anhydride or phthalic anhydride.

The dual-cure binder (A) contains on average at least one of the groups S. The groups S are attached to the respective parent structures of the binders (A) preferably by way of urethane, urea, allophanate, ester, ether and/or amide groups, but in particular by way of ester groups. Normally this is effected by customary and known polymer-analogous reactions such as, for instance, the reaction of pendant glycidyl groups with the above-described olefinic unsaturated monomers containing an acid group, of pendent hydroxyl groups with the halides of these monomers, of hydroxyl groups with isocyanates containing double bonds, such as vinyl isocyanate, methacryloyl isocyanate and/or 1-(1-isocyanato-1-methylethyl)-3-(1-methylethenyl)benzene (TMI.RTM. from CYTEC), or of isocyanate groups with the above-described hydroxyl-containing monomers (a1) and/or (a2).

The reference further discloses a method comprising applying the coating material wherein the substrate is one of a motor vehicle body, a motor vehicle part, a building, a

door, a window, furniture, a part, a coil, a container, a packaging, an electrical component, or a white good. The multicoat paint system had a very good profile of properties in terms of gloss, hardness, and scratch resistance.

The reference discloses a paint coating prepared from a polyester resin composition which inherently is capable of increased crosslinking capability the same components as claimed by applicants including the silyl carbamate component formed from carbamate that results in primary carbonate groups. The concluding step for removing the unreacted carbamate from the reaction process would have clearly been an obvious choice. Note that the reference discloses that several methods may be employed for the formation or incorporation of the carbonate moiety. Further, any properties or characteristics inherent in the prior art, e.g. polydispersity index, content of nonvolatile components, although unobserved or detected by the reference, would still anticipate the claimed invention since the process for making the composition appears to be the same as well as the resulting characteristics. Note In re Swinehart, 169 USPQ 226. "It is elementary that the mere recitation of a newly discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things to distinguish over the prior art". Since the disclosed molecular weights are expressed differently and thus may be distinct from those claimed, it is incumbent upon applicant(s) to establish that they are in fact different and whether such difference is unobvious. Note further that applicant's claim does not

Art Unit: 1711

suggest a particular structural formula and thus is not bound to that which applicants appear to be concluding in applicants arguments. The examiner is interpreting the claim as having both carbamate compound and a silyl compound having a terminal isocyanate group in general. Note that the claim language, as written, is not *necessarily* limiting....i.e. "for reacting with...". In view of the above, there appears to be no significant difference between the reference and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

### **Correspondence**

**Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is ( 571-272-1700).

Art Unit: 1711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb

A handwritten signature in black ink, reading "Terressa Boykin". The signature is written in a cursive, flowing style.

**Examiner Terressa Boykin**

**Primary Examiner**

**Art Unit 1711**